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No. _____

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ALEXANDER J. STEVAS,
CLERK

IN THE

Supreme Court of the United States

October Term, 1982

**J. KAUFMAN IRON WORKS, INC.,
and WINDOR SECURITY SYSTEMS, INC.,**

Petitioners,

-v-

**CECIL SHACKELTON, CARLOS M. QUINONES,
VIVIAN M. WILLIAMS, RICHARD H. WILLIAMS, JR.,
ALFRED C. WILLIAMS and RAYMOND A. WILLIAMS,**

Respondents.

**PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT**

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QUESTIONS PRESENTED FOR REVIEW

1. Can the Second Circuit Court of Appeals be permitted to continue to arrogate to itself fact finding functions contrary to the requirements of Rule 52(a) of The Federal Rules of Civil Procedure; and the mandate of this Court in Inwood Laboratories v. Ives Laboratories, 102 S.Ct. 2182 (1982)?

a) Has the Second Circuit Court of Appeals obeyed the mandate of this Court as set forth in Inwood Laboratories v. Ives Laboratories, 102 S.Ct. 2182 (1982) that "An appellate court cannot substitute its interpretation of the evidence for that of the trial court simply because the reviewing court 'might

give the facts another construction' --"?

b) Has the Second Circuit Court of Appeals complied with the requirements of Rule 52(a) when without finding the trial court's findings clearly erroneous, it substituted its own findings on the ground that the record is "as easily examined by this court as by the court below." (A-7)?

2. Is it proper for an appellate tribunal having a more than heavy docket to devote judicial time and energy to make its own finding to substitute for the findings of a trial court which were not found to be clearly erroneous?

3. Has not the Second Circuit mis-applied the criteria of Graham v. John Deere, 383 U.S. 1 (1976), and Sakraida v. Ag Pro, 425 U.S. 273, for determining patentability under 35 U.S.C. 103, by substituting for the conclusion of the District Court that it would be obvious to replace one standard lock by another standard lock on a standard folding gate, its own conclusion of non-obviousness, particularly when the only testimony shows that those skilled in the art would have found such lock substitution obvious, and where there is no disagreement by the appellate court with the underlying facts found by the trial court that the gate and locks were old?

a) Did the appellate court properly look to the "secondary considerations" of Graham, when the factual background underlying a determination of obviousness had already clearly indicated such obviousness?

4. Has the Second Circuit improperly made an assessment of the personalities of the parties, without the benefit of viewing them, and on the basis of this improper personality assessment, failed to grant the parties equal treatment, and ignored long recognized principles of patent law to find patentability in what the record shows to be an obvious combination of an old lock with an old gate to obtain the function normally expected when the gate and lock are used together?

TABLE OF CONTENTS

	<u>Page</u>
QUESTIONS PRESENTED	1
OPINIONS BELOW	2
JURISDICTION	2
CONSTITUTIONAL PROVISIONS AND STATUTES	3
STATEMENT OF CASE	5
REASONS FOR GRANTING THE WRIT ...	11
<u>I</u> THE SECOND CIRCUIT SHOULD BE MADE TO COMPLY WITH RULE 52(a)	11
<u>II</u> THE SECOND CIRCUIT SHOULD NOT BE PERMITTED TO WASTE JUDICIAL TIME AND EFFORT IN REINTERPRETING FACTS NOT FOUND ERRONEOUS	14
<u>III</u> AN IMPROPER ASSESSMENT OF THE PERSONALITIES OF THE PARTIES SHOULD NOT BE PER- MITTED TO PROVIDE A BASIS FOR IGNORING ACCEPTED PRINCIPLES OF PATENT LAW	15
CONCLUSION	18

APPENDIX

Opinion of the Court of Appeals
dated September 14, 1982 A 1

Judgment of the District Court
dated March 30, 1982..... A 18

Opinion of the District Court
dated March 23, 1982..... A 20

Order of the Court of Appeals
denying rehearing
dated November 8, 1982..... A 51

TABLE OF CASES AND AUTHORITIES

<u>Cases</u>	<u>Page(s)</u>
Graham v. John Deere 383 U.S. 1 (1976).....	111, 8, 17
Inwood Laboratories v. Ives Laboratories 102 S.Ct. 2182	1, 9, 11, 13
Pullman-Standard v. Swint 102 S.Ct. 1781	13
Sakraida v. Ag Pro 425 U.S. 273	111, 16, 17
<u>Statutes and Regulations</u>	
Constitution, Article 1, Sec. 8...	3
28 U.S.C. 1338	2
28 U.S.C. 1291	2
28 U.S.C. 1254(1).....	3
35 U.S.C. 103.....	3, 4, 7, 8
Federal Rules of Civil Procedure - Rule 52(a)....	1, 11, 3, 5, 9, 12, 14

No. _____

IN THE
SUPREME COURT OF THE UNITED STATES

October Term, 1982

J. KAUFMAN IRON WORKS, INC., and
WINDOR SECURITY SYSTEMS, INC.,

Petitioners,

- against -

CECIL SHACKELTON, CARLOS M. QUINONES,
VIVIAN M. WILLIAMS, RICHARD H. WILLIAMS,
JR., ALFRED C. WILLIAMS and RAYMOND A.
WILLIAMS,

Respondents

PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

J. Kaufman Iron Works, Inc., and
Windor Security Systems, respectfully
request that a writ of certiorari issue
to review the judgment of the United

States Court of Appeals for the Second Circuit, reversing the finding of invalidity of a patent by the District Court of the Southern District of New York.

OPINIONS BELOW

The opinion of the Court of Appeals is not reported and is set forth in the appendix (pp. A1-17). The opinion of the District Court is unreported and is set forth in the appendix (pp. A20-50). The unreported order of the Court of Appeals denying petitioners' request for rehearing is set forth in the appendix (pp. A51-52).

JURISDICTION

Jurisdiction of this civil action relating to patents arose in the Federal District Court under 28 U.S.C. 1338, and 28 U.S.C. 1291 in the Court of Appeals.

Jurisdiction of this Court is invoked under 28 U.S.C. 1254(1). The decision sought to be reviewed (A1-17) was entered on September 14, 1982. An order denying a petition for rehearing and/or rehearing in banc was entered on November 8, 1982.

CONSTITUTIONAL PROVISION AND STATUTES

The case presents issues of invention arising under Article 1, Section 8 of the Constitution, and the patent statute 35 U.S.C. 103, as well as requirements of Rule 52(a) of the Federal Rules of Civil Procedure.

(a) Article 1, Section 8 - Congress shall have power To promote the progress of science and useful arts by securing for limited times

to authors and inventors the exclusive right to their respective writings and inventions.

(b) 35 U.S.C. 103 - A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

c) Rule 52(a) - In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. ...

STATEMENT OF CASE

This is a non-jury patent infringement action involving a patent covering an admittedly conventional lazy tongs gate (A5) such as seen on storefronts

after hours, to prevent unauthorized entry. The normal padlock employed on such gates is replaced by an admittedly old lock of the type used on gym lockers (All) accessible from only one side of the gate.

The thrust of the asserted invention is that by employing a lock actuable from only one side of the gate the security of the gate is improved (since outsiders cannot get at the lock) and permits easy egress by the occupants of a protected area in the event of fire.

Petitioners (defendants and appellees below) had originally entered into a license agreement with the patentees, while the patent application was pending, in which there were patent claims covering a gate of the type

produced by petitioners.

The issued patent did not contain such claims, and petitioners cancelled the agreement. Thereafter, suit was commenced, asserting a theory that petitioners were estopped to deny that the patent covered petitioners' gate in view of petitioners asserted marking of the gate as patented. Defendants denied validity of the patent as containing claims defining a combination which would be obvious and unpatentable under 35 U.S.C. 103, and interposed a counterclaim for restitution on the ground that the originally bargained for exclusive right to manufacture was never provided, since the patent application claim covering petitioners' gate never was allowed in the patent, and

the issued patent did not cover petitioners' gate.

The District Court heard the case non-jury and applying the criteria of Graham, supra, to determine patentability under 35 U.S.C. 103 made the factual findings mandated by Graham, supra, regarding 1) content of prior art; 2) differences between prior art and claimed subject matter; and 3) level of skill in the art, and found that the gate defined by the patent claims was a conventional lazy tongs gate, where instead of using a conventional padlock (see A bottom of p. 5 to top of p. 6, and p. 8) employed locks of the type old and well-known, as shown by a number of prior art patents.

The Court of Appeals did not find that the finding of the District Court were erroneous, and, in fact, agrees as it must on the facts as found by the District Court.

However, evoking a principle which it has enunciated in a number of previous cases, the Court of Appeals appears to ignore the requirements of Rule 52(a) of the Federal Rules of Civil Procedure, and ignores the mandate of this Court to it in Inwood Laboratories, supra, and asserts that since the record is "easily examined" by the appellate court, and since there is "very little testimonial evidence" and the District Court's discussion is "rather cursory" the Court of Appeals is not bound by the trial court's findings.

(A7, 8).

The Court of Appeals then reviews the evidence and though not finding the District Court in error, substitutes its interpretation of the prior art, and concludes that the combination of an admittedly old gate with an admittedly old lock is not obvious, asserting with no foundation in the record that the locks of the prior art "function" differently (A10) ostensibly because locking a locker door is different than locking a protective gate.

The appellate court, after reversing the trial court's conclusion of obviousness, remanded to the District Court for consideration of the infringement issue.

Petitioner requested reconsideration and/or in banc rehearing bringing to the Court of Appeals attention, this Court's recent mandate to it in Inwood, supra, without success (A51).

REASONS FOR GRANTING THE WRIT

I THE SECOND CIRCUIT SHOULD BE MADE TO COMPLY WITH RULE 52(a).

The Second Circuit in this case did not even give lip service to Rule 52(a) of the Federal Rules of Civil Procedure, nor to the mandate to it of this Court, as enunciated in Inwood Laboratories, supra, handed down while the instant case was being considered.

Thus, in discussing the "Scope of Review" (A7) the appellate tribunal though conceding that "the district court's factfinding will not ordinarily

be disturbed absent clear error" proceeds to arrogate to itself a broader fact finding function than allowed by Rule 52(a) asserting that a number of previous decisions of the Second Circuit (in which certiorari had been denied) permitted a "broadened" review of the facts (A7), and that in view of an asserted "cursory discussion of the prior art" by the District Court, "deference to those findings is further diminished."

At no time does the Court of Appeals conclude that the findings of the District Court are in error, and instead appears to concur in the District Court's interpretation of the prior art structures (see A11) as indeed it had to. However, the Court of

Appeals contrary to the recent mandate of this Court directed to the Second Circuit in Inwood Laboratories, supra, and in Pullman-Standard v. Swint, 102 S.Ct. 1781 (1982), substituted its interpretation of the prior art for that of the trial court, and evolved a novel theory of function, asserting that a lock employed to lock a gym locker "functions" differently than a lock on a protective gate, since there is no need for "egress from" a locker (All). It is respectfully submitted as clear that the appellate court is mixing function and result.

The problem appears to have arisen because the Court of Appeals did not have the benefit of hearing the testimony with respect to the structures

involved.

The Court of Appeals should be mandated to obey Rule 52(a) and the reliance on cases of the Second Circuit implying that Rule 52(a) can be disregarded should once and for all time be overruled by this Court.

**II THE SECOND CIRCUIT SHOULD NOT
BE PERMITTED TO WASTE JUDICIAL
TIME AND EFFORT IN REINTER-
PRETING FACTS NOT FOUND
ERRONEOUS.**

As noted above, the Court of Appeals did not find the facts found by the District Court to be erroneous, but instead reinterpreted the teachings of the prior art.

Aside from the violation of Rule 52(a) as above discussed, the waste of judicial energy is respectfully sub-

mitted to be highly unproductive.

**III AN IMPROPER ASSESSMENT OF
THE PERSONALITIES OF THE
PARTIES SHOULD NOT BE PER-
MITTED TO PROVIDE A BASIS
FOR IGNORING ACCEPTED PRINCI-
PLES OF PATENT LAW.**

On the basis of what are respectfully submitted to be a number of misinterpretations of the record arising from a lack of opportunity to observe the witnesses, the Court of Appeals in its opinion makes a number of irrelevant findings regarding the personalities of the parties.

Notwithstanding the irrelevant (and in this case what is respectfully submitted to be erroneous) nature of these personality assessments, the Court of Appeals sought to find for those whom it regarded as "the good

guys" and disregarding long recognized principles of patent law, concluded that a claim to a combination of old lazy tong gate and old locker door lock is unobvious and patentable contrary to the conclusion of the District Court based on an assertion that the locker door "functions" differently when used on a protective gate, since locker doors are not used to prevent egress.

The difference between "functions" and "result" were not recognized as in the words of Mr. Justice Brennan in Sakraida v. Ag Pro, 425 U.S. 273 (1976):

"producing a desired result in a cheaper and faster way, and enjoying commercial success, [the invention] did not produce a new or different function."

(Emphasis added.)

Further, with no question but that the prior art showed that lazy tong gates are old (A bottom p. 5) and that locks were long used on lockers (All), the Court of Appeals brought into play the "secondary considerations" of Graham, supra, contrary to the holding of Sakraida, supra, that "commercial success" or "producing a desired result in a cheaper and faster way" or as "a matter of great convenience" does not make patentability without invention.

It appears that the Court of Appeals improperly permitted its assessment of the parties' personalities to color its application of the law.

CONCLUSION

For the foregoing reasons, a writ of certiorari should be granted.

Respectfully submitted,

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